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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77036122
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IN RE: BetaBatt, Inc.

SERIAL NO.: 77/036,122

MARK: DEC

APPLICANT’S APPEAL BRIEF

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I. INDEX OF AUTHORITIES

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II. INTRODUCTION

Appellant, BetaBatt, Inc. (hereinafter “Applicant”), by and through undersigned counsel, hereby appeals to the Trademark Trial and Appeal Board (hereinafter “the Board”) from the decision of the Trademark Examining Attorney (hereinafter “the Office”) refusing registration of its mark, DEC, Serial No. 77/036122.

III. SUMMARY OF PROCEEDINGS

A. Office Action No. 1 (March 21, 2007)

Applicant filed the instant trademark application for DEC to identify:

“Power generating and/or storage devices, namely, batteries deriving power from nuclear decay processes in International Class 9”; and

Treatment of radioactive materials and/or porous substrates for use in the fabrication of power generating and/or storage devices, namely, batteries deriving power from nuclear decay processes; consulting and technical advisory services relating to the treatment of radioactive materials and/or porous substrates, and to the fabrication of power generating and/or storage devices, namely, batteries deriving power from nuclear decay processes in International Class 40.¹

Applicant filed its application under 15 U.S.C. Section 1051(b). On or about March 21, 2007 the Office issued a conditional refusal to register DEC arguing that the mark was primarily descriptive pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). The Office submitted approximately 6 exhibits in support of its arguments including: (i) the results of an acronym search that reveals that DEC has 63 meanings and appears in 24 acronym meanings; (ii) approximately four articles that

¹ Applicant notes that it filed a prior application bearing serial no. 78/505,187 for DEC for identical goods and services. This application was approved, and the examiner did not deny application serial no. 78/505,187 based on descriptiveness, or otherwise.

discuss direct energy conversion; (iii) and a portion of the results of a search from the Google[®] search engine.

Applicant responded to the First Office Action on September 21, 2007.

B. Office Action No. 2 (October 12, 2007)

The Office responded with a second Office Action dated October 12, 2007, wherein the Section 2(e)(1) refusal was made final on the basis that the Mark is primarily descriptive. The Office appended a handful of articles that further discuss Direct Energy Conversion.

The Office relied on these scant references that describe direct energy conversion to find that mark, DEC, was *primarily* descriptive of Applicant's proposed goods and services.

Applicant filed a Request for Reconsideration on April 9, 2008 and timely filed a Notice of Appeal with the Board. The Board suspended the appeal pending the Office's action on Applicant's Request for Reconsideration.

C. Denial of Request for Reconsideration (February 28, 2007)

In the Office's third Office Action dated April 30, 2008, the Office denied Applicant's Request for Reconsideration and maintained its FINAL REFUSAL under Section 2(e)(1). The Office attached additional references that purportedly support Office's assertion that DEC is primarily descriptive consisting of articles that discuss direct energy conversion.

IV. STATEMENT OF ISSUES

The sole issue on appeal is whether the term "DEC" is primarily descriptive.

V. ARGUMENT

Appellant appealed from the Office's refusal to register the above-identified trademark, DEC. The Office refused registration arguing that the mark, DEC, is descriptive of "Direct Energy Conversion." Applicant submits that its mark is not descriptive, and respectfully requests that the Trademark Trial and Appeal Board reverse the Office's decision.

A. DEC is not a Recognizable Acronym

Applicant's mark is not DIRECT ENERGY CONVERSION. The mark is DEC. And if an abbreviation is such that it will not be recognized as merely a shortened form of the original descriptive word, then it is not descriptive. For example, the Board found that NICAD for nickel cadmium batteries was not a recognized abbreviation of "nickel cadmium," and functioned as an arbitrary mark. *Nife, Inc. v. Gould-National Batteries, Inc.*, 128 U.S.P.Q. 453 (TTAB 1961).

Similarly, V-8 was held nondescriptive of juice made from eight kinds of vegetables. *Standard Brands, Inc. v. Smidler*, 151 F.2d 34, U.S.P.Q. 337 (2d Cir. 1945). *See Kampgrounds of America, Inc. v. North Delaware A-OK Campground, Inc.*, 415 F. Supp. 1288, 190 U.S.P.Q. 487 (D. Del. 1976), *aff'd* without op., 556 F.2d 566 (3d Cir. 1977) (KOA with tepee logo held not mere abbreviation of descriptive KAMPGROUNDS OF AMERICA); *In re American Standard, Inc.*, 223 U.S.P.Q. 353 (TTAB 1984) (where an abbreviation for a description of the goods is so vague or fanciful that it will not be readily recognized as merely a shorthand form of the descriptive matter for which it stands, then the mark is not merely descriptive under § 2(e)(1); PS-074 for weatherstripping held not descriptive for lack of evidence of descriptiveness to customers).

Whether a term is descriptive is determined not in the abstract but, rather, in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser or user of the goods or services. *See In re: Bright-Crest, Ltd.*, 204 U.S.P.Q. 591 (TTAB 1979).

DEC, the mark in the instant case, is analogous to NICAD, the acronym for nickel cadmium in *Nife, Inc.* In *Nife, Inc.*, the Board found that Opposer failed to show that any firm, including itself, had ever utilized the designation “NICAD” in the advertising of nickel cadmium storage batteries. *Nife, Inc.*, 128 USPQ at 454. In fact, the Board stated that there was absolutely no evidence to show that any manufacturer or seller of nickel cadmium storage batteries, other than applicant, had ever utilized the notation “NICAD” in any manner whatsoever, oral or written in connection with the sale of such goods. *Id.* The Board reached this conclusion even though there was testimony that NICAD was used as an abbreviation for nickel cadmium in the trade. *Id.*

In this case, Applicant does not dispute that DEC stands for Direct Energy Conversion. However, there is no evidence submitted by the Office that indicates that the common everyday purchaser of a battery that is used in connection with hearing aids or similar medical devices will know that DEC stands for direct energy conversion. Further, as in *Nife, Inc.*, there is no evidence that other manufacturers of batteries utilize the designation DEC as the brand name of their batteries or consulting relating thereto.

B. The Cases cited by the Office are Distinguishable

The Office cites several cases to support its argument that the Applicant’s mark is descriptive. The Office relies on *In re Bright-Crest, Ltd.*, 204 U.S.P.Q. 591 (TTAB

1979) in which COASTER-CARDS for coasters that could be mailed were found descriptive, and *In re MetPath Inc.*, 223 U.S.P.Q. 88 (TTAB 1984) in which the mark, MALE-P.A.P., was found descriptive of testing services for detecting for cancer in men.

The mark, DEC, is clearly distinguishable from the marks in *In re Bright-Crest*, and *In re MetPath Inc.* DEC does not convey, immediately or otherwise, the type of goods and services offered by Applicant, as did COASTER-CARDS, which were literally coasters for use as greeting cards for mailing or MALE-P.A.P, which immediately conveyed that the test at issue was designed for men and related to cancer testing, as identified by the designation P.A.P.

In *In re: Gyulay*, 820 F.2d 1216 (1st Cir. 1987), which is also cited by the Office, the mark the applicant sought to register was “APPLE PIE” used in conjunction with potpourri. The product was designed to actually smell like apple pie. In the opinion, the court noted that the Board implicitly found that the purchasers, upon viewing the term “apple pie” used in conjunction with potpourri, would immediately associate the product with the scent of apple pie. In addition, in *In re: Bed and Breakfast Registry*, 791 F.2d 157 (Fed. Cir. 1986), the descriptive nature of a mark was described as one that would immediately convey to one seeing or hearing it the thought of appellant’s services. Further, whether a mark is merely descriptive is a question of fact, determined from the viewpoint of the relevant purchasing public.

The mark, DEC, is distinguishable from the words, “Apple Pie” and “Bed and Breakfast Registry,” as it does not immediately convey a description of batteries that derive power from nuclear decay processes or consulting related thereto. The standard set out in the aforementioned cases regarding whether a term is descriptive is from the

viewpoint of the relevant purchasing public. The acronym, DEC will not immediately convey to the average consumer and purchaser of batteries, the thought of batteries that derive power from nuclear decay processes or consulting related thereto. In fact, in none of the evidence cited by the Office is there any reference to companies selling batteries that utilize the acronym, DEC.

While the Office utilizes a handful of print outs from various Web sites that simply mention Direct Energy Conversion in general, none of the print outs mention the acronym, DEC used alone in connection with the goods and services offered by Applicant. Moreover, it is highly questionable that a consumer would even know that DEC is an acronym for Direct Energy Conversion.

Conversely, if the Office were to run a search on the words “Apple Pie” and “Bed and Breakfast” dozens of uses, or perhaps hundreds would appear. This supports the aforementioned cases holding that the common consumer knows the meanings of these words. In fact, apple pie and the smell of apple pie is something that is commonly referred to as “American,” and Bed and Breakfast establishments are encountered in most areas. Moreover, unlike “Apple Pie” or “Bed and Breakfast” the acronym DEC or even “Direct Energy Conversion” is not well known. It is highly unlikely that the average consumer would immediately associate the mark DEC with the services offered by Applicant.

C. Applicant’s Mark is Suggestive

Moreover, Applicant respectfully submits that DEC is not merely descriptive because it is not possible to associate the mark with Applicant’s services without a multi-stage reasoning process and additional information. If a multi-stage reasoning process is required to determine attributes of the applicant’s services, a mark is not descriptive. *See,*

McCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, vol. 2, §11:67; *In Re Tennis in the Rand, Inc.*, 199 U.S.P.Q. 808 (9th Cir. 1979). “Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought or perception to reach a conclusion as to the nature of those goods or services.” TMEP §1209.01(a).

The instant case is more analogous to *Tanel Corp. v. Reebok Int’l, Ltd.*, 774 F.Supp. 49, 16 U.S.P.Q.2d 20354 (D. Mass. 1990) in which the mark, 360°, was found to be suggestive of sports shoes because one must use considerable imagination to remember that 360 is the number of degrees in a circle, connect that circle to movement and image that the mark connotes the ability to pivot in the shoe for a full circle.

In this case, a consumer will not readily know what DEC stands for, and even if a consumer did know, the consumer would still have to conduct some multi-stage reasoning to determine the operation of Applicant’s products. The term, DEC, does not describe in any clear or precise way (or an indirect way), the goods or services offered under this trademark, and the Internet excerpts cited by the Office do not support this finding either. If the information a mark conveys is indirect or vague, as in this case, and if imagination, thought and additional information are needed to reach a conclusion as to the exact nature of the services then a mark is suggestive and not merely descriptive. *McCARTHY, Id.*, §11:67.

DEC is also analogous to the mark “Slick Craft” described in *AMF, Inc. v. SleekCraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979). The test for suggestiveness is whether a mark sheds some light upon the characteristics of the goods but involves an element of incongruity, and in order to be understood as descriptive, the mark must be

taken beyond such a suggestive or figurative sense through an effort of imagination on the part of the observer. *See, General Shoe Corp. v. Rosen*, 111 F.2d 95 (4th Cir. 1940).

The mark, DEC, is similar to the mark, “slick craft” in *AMF, Inc. v. SleekCraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979). In *AMF* the word “slick” was used to depict certain qualities of a boat. The boat was promoted as fast recreational ski boat with a cutting edge hull. *AMF*, 599 F.2d at 350. And the Court found that the word “craft” was a commonly used term for boat. *Id.* at 351. The mark was considered suggestive because it did not readily describe the boat, but required some thought on the part of the consumer. In addition, the image conjured up by the consumer was not the product, the boat, but other images as well. *Id.* at 350.

In this case, as in *AMF*, the consumer must give some thought to all elements of the mark: in this case the meaning of the acronym, DEC, is not likely to be readily known (or known at all) by the purchasing public before making a connection between the mark and Applicant’s services. As already mentioned above, descriptive words define qualities or characteristics of a product in a straightforward way that requires no exercise of the imagination to be understood, and a suggestive mark is one for which a consumer must use imagination or any type of multistage reasoning to understand the mark’s significance. Even if DEC is known in meaning to the consuming public it is not descriptive of “power generating and/or storage devices, namely, batteries deriving power from nuclear decay processes” and “treatment of radioactive materials and/or porous substrates for use in the fabrication of power generating and/or storage devices, namely, batteries deriving power from nuclear decay processes; consulting and technical advisory services relating to the treatment of radioactive materials and/or porous substrates, and to

the fabrication of power generating and/or storage devices, namely, batteries deriving power from nuclear decay processes.” Therefore, the mark must be taken in a suggestive or figurative sense through an effort of imagination on the part of the observer rendering the mark suggestive and not descriptive.

D. Internet Evidence cited by the Office does not Demonstrate that the Mark is Descriptive.

Further, the fact that a mark may impart certain information about the physical characteristics of the goods does not render it incapable of functioning as a trademark. *In re DC Comics, Inc.* 215 USPQ 384 (CCPA 1982).

Excerpts from articles taken from the Internet may be competent evidence in an ex parte proceeding of how a mark may be perceived by the public. *See In re Fitch IBCA, Inc.*, 64 USPQ2d 1058 (TTAB 2002). But in this case, most of the instances in which “DEC” appears simply describe the process of direct energy conversion, and do not describe products (batteries or otherwise) offered for sale under the mark, DEC. Further, the appended evidence does not discuss consulting services utilizing the DEC mark either. As such, these articles do not demonstrate that DEC by itself is merely descriptive of the goods and services that Applicant intends to offer.

The Internet articles submitted by the Office are insufficient to make a prima facie case that consumers in the United States would view DEC as merely descriptive of a feature or characteristic of applicant’s goods and services. It is not clear that ordinary consumers would be aware of, or be familiar with Direct Energy Conversion or more accurately that DEC stood for Direct Energy Conversion. Second, even if such familiarity may be presumed, the evidence of record still falls short of demonstrating that DEC merely describes Applicant’s goods and services. Finally, if doubt exists as to

whether a term is merely descriptive, it is the practice of this Board during ex parte prosecution to resolve doubts in favor of the applicant and pass the application to publication. *See In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972). *In re Micro Instrument Corp.*, 222 USPQ 252, 255 (TTAB 1984); *In re LRC Prods. Ltd.*, 223 USPQ 1250, 1252 (TTAB 1984).

Respectfully submitted,

Date: July 8, 2008

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